

elements (including but not limited to (e)-(g)) to the recited (a)-(d).

5. Under PCT administrative Instructions, Annex B, paragraph (c) ("independent and dependent claims"), "if the independent claims avoid the prior art... no problem of unity arises in respect of any claims that depend on the independent claims. In particular, it does not matter if a dependent claim itself contains a further invention". We believe the same principle should have been applied to the "optional" limitations of prior claim 1; they cannot create a unity problem if the mandatory limitations (a)-(d) define patentable subject matter. The Examiner has not made any showing that the combination (a)-(d) is in the prior art.

By moving (e) and (f) to dependent claims, we clearly bring those embodiments under the protection of PCT Administrative Instructions Annex B, paragraph (c).

Consequently, groups I-B through I-G should be joined with I-A.

5. The Examiner argues that groups II and III, while nominally dependent on claim 1 because they refer to it, don't satisfy the PCT definition of a dependent claim. That is correct.

However, claim 48 (group II) has been amended to create a combination-subcombination relationship between it and claim 1. That is, the "control means" of claim 48 now comprises the breeding system of claim 1. Such is also protected by Annex B(c), which says, "no problem arises in the case of a combination/subcombination situation where the subcombination claims avoids the prior art and the combination claim includes all features of the subcombination". Consequently, group II should be joined with group I.

6. Claim 58 (group III) has been amended to clarify that it is a method of using the breeding system of claim 1.

Therefore, it should be joined with group I as they have a relationship of product/method of use, per PCT administrative instructions, Annex B, paragraph (e)(1) (allowing independent claims to both).

7. PCT species restriction practice is defined by Annex B, paragraph (c). Subparagraph (i) states "no problem arises in the case of a genus/species situation where the genus claim avoids the prior art". Subparagraph (ii) then explains that if the independent (generic) claim does not avoid the prior art, and there is no remaining "inventive link" among the dependent (species) claims, the examiner should hold that there is a lack of unity a posteriori (after consideration of prior art) lack of unity, per para (c)(ii). The Examiner must cite prior art for this to be proper.

Under U.S. practice, if a species restriction is made, it is withdrawn if a generic claim is deemed allowable (more precisely, novel and nonobvious). Under PCT practice, the equivalent a posteriori lack of unity holding requires a prima facie showing that the generic claim is anticipated by or obvious over the cited art, and, of course, this can be rebutted during prosecution or the generic claim amended to distinguish the prior art, resulting in withdrawal of the lack of unity objection.

The species restriction is traversed on the following grounds: (1) the Examiner did not cite prior art to justify the species restriction, and (2) generic claims are in fact allowable.

9. The elected species is species 3, which the Examiner identifies by reference to claim 3 (means for automatically identifying each of the individual animals).

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In our opinion, all of the group I claims are generic to the elected species, because none of those claims is inconsistent with automatic identification (i.e., none requires manual identification or no identification).

Respectfully submitted,

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